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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,190	08/31/2001	Daniel M. Wing	1242.017	1208
7590	04/29/2004		EXAMINER	
John Pietrangelo Heslin Rothenberg Farley & Mesiti P.C. 5 Columbia Circle Albany, NY 12203			DESANTO, MATTHEW F	
			ART UNIT	PAPER NUMBER
			3763	<i>23</i>

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/944,190	WING ET AL.
	Examiner	Art Unit
	Matthew F DeSanto	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 February 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 9,11-13,22,23,25-40,42-44,48-51,54 and 59-82 is/are pending in the application.

4a) Of the above claim(s) 27-30,32-40,42-44,50 and 51 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 9,11-13,22,23,25,26,31,48,49,54 and 59-82 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 31 is objected to because of the following informalities: the wording is unclear in the last paragraph "wherein the obturator axially deflects wherein the second tapered surface of the first end of the obturator impinges..." Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 9, 11-13, 31, 48, 49, 59 - 64, 75, 76, & 78-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al. (USPN 5290294).

Cox et al. disclosed a trocar assembly with a cannula (12) and an obturator (18) and a first (22) and second (24) bearing surface. (Figure 2). Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula.

As to claims 11-13, wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface. (Figure 2).

As to claims 48 and 49, wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator. (Figure 2, and entire reference).

As to claims 59-61, 63, 64, 75 and 76 wherein the head assembly has a bearing surface, a fluid port with a valve.

4. Claims 9, 11-13, 31, 48, 49, 54, and 59-82 rejected under 35 U.S.C. 102(b) as being anticipated by Riza et al. (USPN 5,993,471).

Riza et al. discloses trocar assembly with a cannula and an obturator and a first (19) and second (16A) bearing surface. Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula as well as wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface, and wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator, and wherein the head assembly has a bearing surface, a fluid port with a valve. (See Figures 2, 3, 4 and entire reference)

5. Claims 22, 23, 25, 26, and 66-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (USPN 5807338).

Smith et al. discloses a trocar assembly with a cannula (112) and obturator (110), As to claim 23, wherein the cannula is uniformly tapered from a second inside diameter, larger than the first inside diameter. (Figures 1, 14 and 18 and entire reference).

As to claims 25, 26, wherein the obturator comprises a first tapered surface extending from the maximum diameter of the first end to the tip and a second tapered surface extending from the maximum diameter to the outside of the shaft. (Figure 2, 5, and 12 and entire reference).

As to claims 66-68, 70-71, and 73 wherein the head assembly has a bearing surface (Figure 2 and 16), a fluid port with a valve. (Figures 14 and 16 and entire reference).

As to claim 69 wherein the head assembly comprises a seal. Figure 14.

As to claim 72 wherein the cannula is non-metallic, column 5, lines 8-19.

6. Claims 22, 23, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Shipp (USPN 5,263,937).

Shipp discloses an obturator, a cannula, wherein the cannula has a flexible, smooth and continuous inside surface. (Figures 1-4, 7 and entire reference)

Response to Arguments

7. Applicant's arguments filed 2/5/04 have been fully considered and are persuasive with regards to Schwemberger (USPN 5,997,510) and Taylor (USPN 4,405,307) and the 102 Rejections are withdrawn. The arguments are not persuasive with regards to Cox, Shipp and Smith.

With regards to claim 22, the examiner disagrees with the applicant. Both Smith and Shipp have an obturator with a first end having a smooth and continuous taper. (Shipp – Figures 3 & 4 and Smith – Figure 4A reference number 212)

8. With regards to the Smith reference according to Figures 5 and 6 the outer diameter of the obturator has a knife blade that extends further out then the diameter of the obturator, therefore, when looking at figure 1, the diameter of the obturator (128) would be larger then the inner diameter of the cannula (116) because of the slits at the obturator to allow the knife to pass through. The applicant next argues that Smith does not teach a cannula that has an inside that is flexible, smooth and continuous. The examiner states that reference number 112 is a cannula. A cannula is a flexible tube according to (*The American Heritage® Dictionary of the English Language, Fourth Edition*. Copyright © 2000), and that is exactly what 112 is. Next the applicant states that the cannula is not flexible. This term is extremely broad, because everything has a certain degree of flexibility even on the microscope scale, so unless the applicant is more specific about the degree of flexibility this cannula has a certain degree of flex, thus making it flexible.

9. With regard to Cox the bearing surface with impinge and cause deflection. This is how the apparatus works and how the obturator is separated from the cannula.

10. In response to applicant's argument that there is no "bearing surface" that causes axial and radial deflection is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re*

Otto, 136 USPQ 458, 459 (CCPA 1963). With regards to Cox, in Figure 2, the hooks (ref. 24) are going to be place into grooves (ref. 22) and thus lock the obturator. The deflection is going to occur when the obturator's hooks are placed in the grooves of the cannula and rotated until the obturator is locked in place, thus by doing this in either direction the obturator is being displaced. (i.e. from the locked to unlocked position or from the unlocked to the locked position.)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew DeSanto

Matthew DeSanto
4/18/04

Brian L. Casler
BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700